



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/544,950 10/16/95 ROBE

D 380931APP

E5M1/C916

WOLFE, EXAMINER

EPSTEIN EDELL & RETZER
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE MD 20850-3164

ART UNIT	PAPER NUMBER
----------	--------------

2512

3

DATE MAILED:

09/16/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/544,950

Applicant(s)

ROSE

Examiner

John H. Wolff

Group Art Unit

2512



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-30 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/544,950

-2-

Art Unit: 2512

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-9 and 17-19, drawn to a p.c. data card comprised of plural layers and the method for affixing plural such layers onto a data card, all classified in Class 360, subclass 131.

Group II. Claims 10-16, 20-27 and 28-30 drawn to an adapter for receiving a data card for insertion into a floppy disk drive, classified in Class 360, subclass 55.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed as the combination does not call for nor require the first-third or fourth-fifth layers of the p.c. data card of group I. The subcombination has separate utility such as in an environment distinct from the

Serial Number: 08/544,950

-3-

Art Unit: 2512

outer shell and/or the floppy disk environment set forth in invention II.


3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent search and recognized contrastable subject matter restriction for examination purposes as indicated is proper.

4. A telephone call was made to Mr. Edell on August 27, 1996 to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John H. Wolff whose telephone number is (703) 308-3215.

JHW
August 27, 1996


JOHN H. WOLFF
PRIMARY EXAMINER
GROUP 2500